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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,044	10/31/2003	Matthew Murray Williamson	1509-460	9711

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EXAMINER	
HENEGHAN, MATTHEW E	
ART UNIT	**PAPER NUMBER**
2134	

NOTIFICATION DATE	DELIVERY MODE
01/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/697,044	WILLIAMSON ET AL.	
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 21-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14,21-23 and 25-32* is/are rejected.

7)☒ Claim(s) *24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the previous office action, Applicant has amended claims 1, 3, 4, 7-14, and 21-28; cancelled claims 15-20; and added claims 30-32. Claims 1-14 and 21-29 have been examined.

Claim Objections

2. Claim 22 is objected to because of the following informalities: The claim lacks a transitional phrase in the preamble. The word "wherein" as used in the amended claim in not a suitable transitional phrase. See MPEP 2111.03 and 2111.04. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 21-23, 25, 26, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,096,498 to Judge in view of U.S. Patent No. 7,159,149 to Spiegel et al.

As per claims 21-23 and 32, Judge discloses a system in which a whitelist (a list of those nodes with which contact is permitted), which is the first record in a set of records, is constructed by monitoring interactions by a node, using parameters such as outbound email addresses, with other hosts over an initial period (see column 26, lines 1-7), whitelisting those nodes contacted more than a certain number of times. Further transactions are checked against the one or more whitelist records and those appearing on the list may be exempted from further countermeasures (see column 25, lines 7-23). Countermeasures may include throttling the number of communications with non-whitelisted nodes per unit time (see column 31, lines 17-19).

Judge does not disclose the blocking of dispatches based upon a characteristic reaching a threshold or the limiting of outgoing traffic from a source.

Spiegel discloses the blocking of a message if it involves failed connection attempts from multiple sources with action being taken with respect to outgoing messages from a source after a determination of a worm attack (see abstract and column 7, lines 34-58), with all traffic (including outbound) related to that source being affected.

Therefore it would have been obvious to one of ordinary skill in the art to modify Judge for regulating both inbound and outbound messages and by blocking messages

for which a characteristic (such as failed connection attempts) reaches a threshold as per Spiegel's analogous invention.

As per claims 25 and 26, requests may be quarantined (stored for later processing) as a countermeasure (see column 31, line 15).

Regarding claim 29, Judge's system may be instantiated on a network having multiple nodes (see figure 2).

As per claims 30 and 31, additional whitelists may be used to employ multiple levels of trust in message interrogation, according to a connection characteristic such as frequency of use, thus giving priority to messages in a particular whitelist (the second record) (see column 25, lines 28-47).

4. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,096,498 to Judge in view of U.S. Patent No. 7,159,149 to Spiegel et al. as applied to claim 26 above, and further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

Judge and Spiegel do not discuss the manner in which the quarantine is to be maintained.

Hursey discloses a quarantine procedure in which quarantined messages are placed in a queue. In queue structures, the items are, by default, stored in the order in which they were enqueued (temporal order). Hursey discloses further testing of the queue members in light of subsequent messages, and pops items from the queue (effectively moving them to the front of the queue) if further processing is found to be

necessary, with some queue members be popped and transmitted on a per unit time basis (see paragraphs 37-39). This is done to address the problem of mass mailed malware that is a sequence of separate email messages (see paragraph 17).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Judge and Spiegel by using Hursey's quarantine methods, to address the problem of mass mailed malware that is a sequence of separate email messages.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-15, 21-23, and 25-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/457,091 in view of U.S. Patent No. 7,096,498 to Judge

further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al. in view of U.S. Patent No. 7,159,149 to Spiegel et al.

Claims 1 of the '091 application discloses the first two limitations of claim 1 of the instant application, but does not claim an additional selection process.

Judge discloses a whitelisting process for selection, as described above, in order to avoid using time to scrutinize trusted nodes.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claim of the '091 application as per Judge, in order to avoid using time to scrutinize trusted nodes.

Claims 2-15, 21-23, and 25-32 are likewise obvious over the '091 application in view of Judge, Hursey, and Spiegel for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 1-15, 21-23, and 25-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/687,694 in view of U.S. Patent No. 7,096,498 to Judge further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

All of the limitations of claim 1 of the instant application are claimed in claim 3 of the '694 application. Claims 2-15, 21-23, and 25-32 are obvious over the '694 application in view of Judge, Hursey, and Spiegel for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claim 1-15, 21-23, and 25-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/697,645 in view of U.S. Patent No. 7,096,498 to Judge further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

All of the limitations of claim 1 of the instant application are claimed in claim 14 of the '645 application. Claims 2-15, 21-23, and 25-32 are obvious over the '645 application in view of Judge, Hursey, and Spiegel for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-15, 21-23, and 25-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/833,057 in view of U.S. Patent No. 7,096,498 to Judge further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

All of the limitations of claim 1 of the instant application are claimed in claim 1 of the '057 application. Claims 2-15, 21-23, and 25-32 are obvious over the '057 application in view of Judge, Hursey, and Spiegel for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

9. Claims 1-14 would be allowable if rewritten or amended to overcome the rejection(s) under the doctrine of double patenting set forth in this Office action.

10. Claim 24 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, Though Judge discloses the excluding of nodes from countermeasures, no art could be found that recited to limiting of transmissions to a specific number of hosts as such a countermeasure. Hursey discloses the limiting of outgoing communications to a number of hosts that exceed a threshold, but this is done on a per transaction basis rather than per unit time (see Hursey, paragraph 33).

Claims 2-14 would be allowable based upon their dependence upon claim 1.

Regarding claim 24, no art could be art found that suggested throttling according to a least requested characteristic.

Response to Arguments

12. Applicant's arguments, see Remarks, filed 23 October 2007, with respect to the rejections of claims have been fully considered and are persuasive in view of Applicant's amendments. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Spiegel.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450
Or faxed to:
(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

Primary Patent Examiner, USPTO AU 2134

December 28, 2007